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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D., 1941.

No. 720.

MILCOR STEEL COMPANY,
Petitioner

vs.

GEORGE A. FULLER COMPANY, NEFF LATHING COMPANY, INC., and CONVER STEEL & WIRE COMPANY, INC.,
Respondents

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

MALCOLM K. BUCKLEY,
CONRAD CHRISTEL,
Counsel for Respondents.

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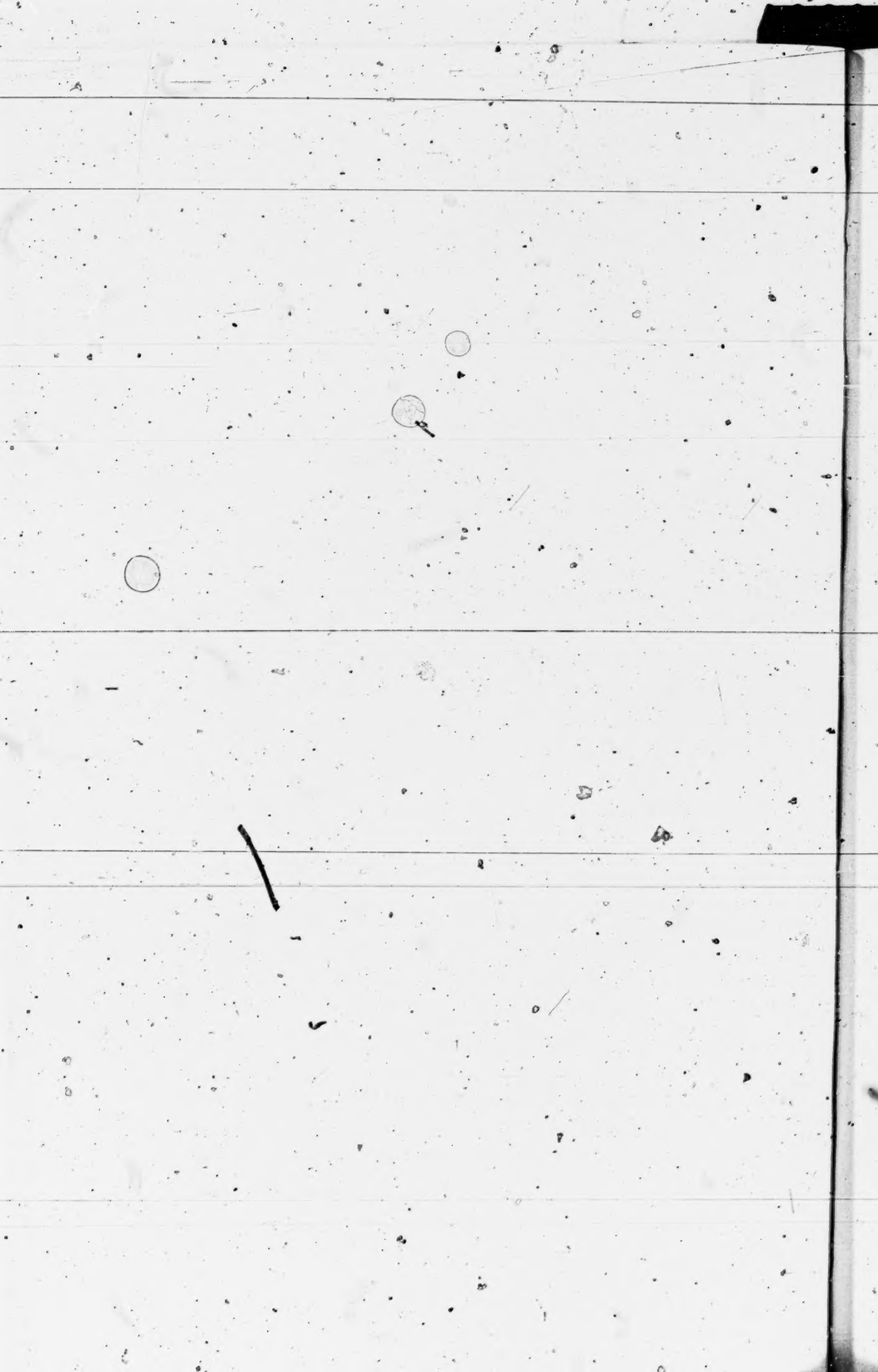

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Additional Statement.

The Courts below, with no dissenting voice, found that the only two patent claims in suit were invalid by reason of improper disclaimers. The accused disclaimers sought, after issue joined in this action, to amend the claims and make them more specific by adding elements thereto. The doctrine that the addition of elements to claims by disclaimers is an invalid practice was approved and applied by this Court in the leading case of Altoona Publix Theaters Inc. v. American Tri-Ergon Corp., 294 U. S. 477.

There is no valid reason for review of the instant case because in all of the cases asserted by the Petitioner to be in conflict with it, the Courts found no added elements in the questioned disclaimers. There is no conflict of decision on the validity of the patent at bar and the case is simply one of a disappointed litigant seeking further avenue of review.

The Three Questions Which the Petition Alleges are Presented.

Clear support will be found in the ensuing discussion of the opinion below for the following answers to Petitioner's "Questions Presented."

1. The instant decision does not conflict with the judgments of the Sixth, Seventh and Ninth Circuits but merely disagrees, *obiter*, with its philosophy on disclaimers.

2. Since both the District Court and the Court of Appeals found actual physical elements had been added to the two claims in suit, Question No. 2 is not presented in this case.

3. So far as a case like the present one is concerned, this Court, with respect to Question No. 3, could add nothing to what it clearly stated in the Altoona case.

The answers to Petitioner's three "Questions Presented" constitute likewise an answer to its "Specification of Errors" which closely follow the "Questions" in form.

An Analysis of the Opinion Below.

We believe the following to be a fair synopsis of the opinion below:

1. A definite finding that actual physical elements were added to each of the two claims at bar by the attempted disclaimers producing new combinations, whatever construction be given to the word "elements" as used in the decided cases, including Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., *supra*. The claims accordingly fall by any criterion.

2. Although some courts speak as though modifying disclaimers which do not add a new element are valid, it is believed that all limiting disclaimers are outside of the intent of the disclaimer statute and should be held invalid.

In this latter disputation, which is obviously *obiter dictum*, the respondents wish to have no part, since a review of the present case would remove none of the doubt alleged to surround some phases of the question for the simple reason that those phases are not presented in this case. A decision against the claims would be merely reiteration of the Altoona doctrine but with decidedly less emphasis because of the clearer presence of added elements here. A decision for the claims would merely reverse the Altoona case. The cases relied upon by the Petitioner, as in conflict with that case, in every instance expressly find that no elements are added by the accused disclaimers.

The petitioners endeavor adroitly to infer that the broad philosophy of the opinion of the Second Circuit Court is not consonant with opinions of other circuits. It is true that the opinion of the Circuit Court of Appeals criticizes the opinions relied upon by petitioners, but that criticism is purely *obiter*.

This is not a case where the Supreme Court has been silent and various Circuits have spoken in conflict. It is a case where the instant Circuit speaks in harmony with this Honorable Court; any veiled hints that other Circuits have not is purely *obiter* and do not warrant a review of this case to test the correctness of other decisions not controlling here.

The opinion of the Circuit Court of Appeals divides conveniently into the two severable parts indicated by the foregoing analysis. Part one extends from the beginning through the fifth paragraph, the second last sentence of which reads:

> "The result of the disclaimers was therefore to add to claim six a new element: 'the depending perforated flange,' and to claim seven also a new element: 'the recesses to receive the bottoms of the channel irons.'"

The remainder of the opinion comprises part two of the analysis.

Authorities Alleged by Petitioner to Show Conflict Between Circuits.

A review of the various cases set forth on page 4 under ground 1 in the Petition for Writ of Certiorari is believed not to be in point here since in Johnson Laboratories Inc. v. Meissner Mfg. Co., 98 F. (2d) 937, the Court stated, p. 945:

> "We think the disclaimer is within the statute, that it adds no new elements * * *."

In Payne Furnace and Supply Co. Inc. v. Williams-Wallace Co., 117 F. (2d) 823, the Court, in commenting upon the disclaimer, stated:

"We doubt the disclaimer was necessary, for these limitations were already implicit in the spirit of the invention claimed."

In Byrne Mfg. Co. v. American Flange & Mfg. Co., 87 F. (2d) 783, the Court, in commenting upon the disclaimer, stated:

"The disclaimer adds no new elements."

In Cincinnati Rubber Mfg. Co. v. Stowe-Woodward, Inc., 111 F. (2d) 239, the disclaimer merely stated that the roll of the claim was for use in paper making machines.

In none of the foregoing cases did the courts find that elements had been added to the claims by disclaimer.

The Fallacy of Petitioner's "Reasons for Granting the Writ."

1. THE DECISION IN THIS CASE IS NOT IN CONFLICT WITH THE JUDGMENTS OF THE SEVENTH, NINTH AND SIXTH CIRCUITS CITED IN PARAGRAPH 1 OF PETITIONER'S REASONS. The Court below does not admit its judgment conflicts with those cited by petitioner. The opinion merely states that it does not agree with their reasoning.

2. THE JUDGMENT BELOW IS NOT IN CONFLICT WITH ALTOONA PUBLIX THEATRES, INC. V. AMERICAN TRI-ERGON CORP., *SUPRA*. The simple fact is that both the District Court and the Circuit Court of Appeals based their decisions on the Altoona case with which petitioner states the present case conflicts. Since both the Altoona case and the present case hold the dis-

claimers complained of bad, there could be no conflict in any event.

3. THE ANSWER TO THE QUESTION OF FEDERAL LAW PRESENT IN THIS CASE HAS BEEN FULLY ENUNCIATED BY THIS COURT IN THE ALTOONA CASE, *SUPRA*. The inconsistence of petitioner in stating that the present case conflicts with an applicable decision of this Court and likewise presents a question not settled by this Court is obvious.

The following from the opinion of this Court in the Altoona case is clear and unequivocal:

> "A patent amended by disclaimer thus speaks from the date of the original patent, while the reissued patent, with respect to the amended claim, speaks from the date of reissue. If respondent could thus, by disclaimer, add the flywheel to the arcuate flexing claim and to the optical claim, he would in effect secure a new patent operating retroactively in a manner not permitted by the reissue statute and without subjecting the new claims to revision or restriction by the customary Patent Office procedure required in the case of an original or reissued patent. Such transformation of a patent is plainly not within the scope of the disclaimer statute, and the attempted disclaimer as applied to claims 9 and 13 is void."

4. THE CONSTRUCTION AND APPLICATION OF REVISED STATUTES SECTION 4917, U. S. C. TITLE 35, SECTION 65 IS FULLY EXPOUNDED BY THIS COURT IN THE ALTOONA CASE. The facts in the present case as to the nature of the disclaimers involved are so like those present in the Altoona case that petitioner has never presented, here or below, any reasonable ground for distinguishing the present case from the Altoona case.

In the Altoona case, referring to the construction and application of the disclaimer statute (Revised Statutes Section 4917, U. S. C. Title 35, Section 65), this Court said:

> "While this statute affords a wide scope for relinquishment by the patentee of part of the patent mistakenly claimed, where the effect is to restrict or curtail the monopoly of the patent, it does not permit the addition of a new element to the combination previously claimed, whereby the patent originally for one combination is transformed into a new and different one for the new combination."

Conclusion.

It is submitted that the Petition presents no sound reason for review of the instant case by this Honorable Court.

Supplemental Discussion of the Structure at bar and the Disclaimers per se.

The following supplemental discussion is added, should the Court desire to consider further the questions involved.

Nature of the Invention Involved.

To familiarize the Court with the general nature of the subject matter involved in this action, reference is had to the disclosure of the patent to Orr No. 913,152 dated February 23, 1909 (R. 54) relating to partition walls. For convenience of reference the drawing of the Orr patent is here reproduced. It will be noted that the patent relates to partition walls, that is to say, walls which are non-load bearing. The patent also relates particularly to partitions which are designated as "solid partitions" as contrasted with partitions made of two walls and having an air space therebetween. Referring to the patent, it will be noted that Fig. 1 is a section through a non-load bearing or partition wall. Referring to Fig. 2, it will be seen that the skeleton framework of the wall is formed by upstanding wall supports, designated e, of channel cross-section. These channels are assembled with floor members designated 10 having raised portions 3 formed to receive the lower ends of the channel wall supports. Ceiling members 11, having downwardly extending formations 4 apertured to receive the upper ends of the channel wall supports e, are provided in order to complete the skeleton assembly over which wire mesh is laid for carrying and supporting the plaster.

Orr states:

> "The partition, in the form shown, consists of the metal studs e, to which is laced on one or both sides by-

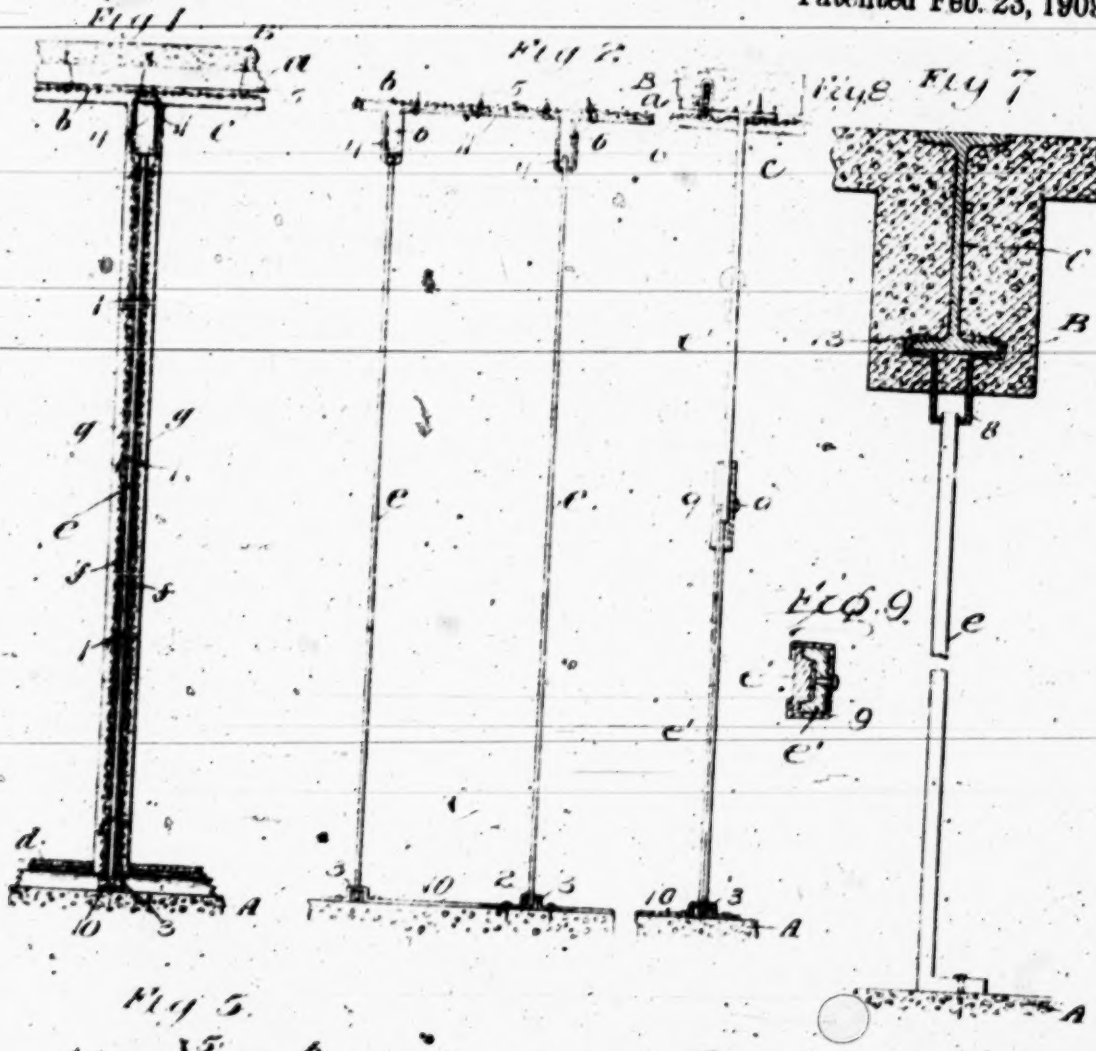
W. ORR.

FIREPROOF PARTITION.

APPLICATION FILED OCT. 13, 1907.

913,152.

Patented Feb. 23, 1909.



Witnesses
[illegible]
[illegible]

Inventor
William Orr
by his Attys
Phelps, Dunwoody & Kennedy

wires 1 the metallic lathing f, to which is applied the plaster g to complete the partition, the partition shown being of that class known as 'solid partitions' with no central air space."

With this understanding of solid partition or non-load bearing walls, reference may be had to the Holdsworth patent in suit No. 2,105,770 (R. 47). Figs. 1 and 2 of the Holdsworth patent in suit disclose a conventional floor and ceiling between which it is desired to extend a vertical partition wall. A floor member having raised portions to receive the lower ends of upstanding wall supports is secured to the floor of the room. The raised portions are formed with recesses 4 for assembly with the vertical wall supports 6. The vertical members are assembled at their upper end with an elongate ceiling member or angle iron 7 one flange of which is secured directly against the ceiling, the other flange depending therefrom. In the form illustrated specifically in the drawing these upstanding wall supports are notched at their upper ends as at 8 in Fig. 2, and the notches, when the parts are assembled, extend downwardly farther than the terminal portion of the ceiling member 7 whereby the elements 6 may be moved vertically relative to the base and ceiling members. Holdsworth states that this particular construction is provided for assembly and to permit the use of vertical members varying in length.

In particularizing the construction Holdsworth pointed out that he was not to be restricted to particular forms of upstanding wall supports or to particular forms of ceiling members since he states in the specification, p. 2, col. 2, lines 43-47 (R. 49):

"Whenever I refer to channel irons, I do not wish to be limited to any form of vertical supporting members, and I do not wish to be limited to an angle iron for completing the top of the metal construction."

The Purported Invention of Original Claims 6 and 7.

Claims 6 and 7 as originally granted by the Patent Office and before the attempt to change their context by the amendatory disclaimers contained the following element :

a. a base member,

b. a ceiling member,

c. upstanding wall supports whose height is less than the maximum vertical distance between said base member and said ceiling member,

and (claim 6)

d. means operative to prevent any substantial tilting movement of said wall supports.

Element (d) of claim 7 provided that the means recited in (d) should be shaped in said base member and said ceiling member.

The Disclaimers.

The broad concept of these two claims related definitely to these four elements. Claim 6, as amended by disclaimer, sought to add as new elements:

(1) a vertical depending perforated flange on the ceiling, and

(2) metal lathing overlapping one side of the vertical depending flange.

The attempted amendatory disclaimer to claim 7 attempted to add as new elements recesses in the base member and recited that the wall supports were formed with flanges overlapping the base member adjacent the recesses.

Thus, the broad inventive concept set forth in claim 6 and directed to the vertical movability of the upstanding

wall supports after assembly with the ceiling member and floor member was, after disclaimer, directed to a very specific construction setting forth the characteristics and cooperation of the ceiling member, the upstanding wall support and metal lathing.

In reverse fashion, the broad concept of claim 7 was changed by the addition of the new element to a specific relationship between a specific form of base member and a specific form of upstanding wall support, namely, a base member having "recesses" to receive the lower ends of supports having "webs" and wherein the supports have "flanges" overlapping the base member adjacent the recesses. (The elements in quotation marks being recited for the first time in the disclaimer.)

It is just such changes as these, where claims originally directed to one combination are, by the addition of an element or elements, directed to a new and different combination, that this Court declared to be repugnant to the disclaimer statute in the Altoona case.

It is respectfully submitted that the Petition should be denied.

Respectfully submitted,

MALCOLM K. BUCKLEY,
CONRAD CHRISTEL,
Counsel for Respondents.

Buffalo, New York,
November 14, 1941.